

REMARKS

Claims 1-3, 9-12, 15-22 and 27-35 are pending in this application. Claims 4-8 and 23-26 have been withdrawn as a result of the Restriction Requirement issued on October 10, 2006. Claims 13 and 14 have been cancelled without prejudice or disclaimer of subject matter. Claim 1 has been amended to more clearly define applicants' invention, claim 3 has been amended to correct a typographical error, and claim 15 has been amended to change its dependency due to the cancellation of claim 14. Claims 1 and 35 are in independent form. Favorable reconsideration and allowance of the subject application are respectfully requested in view of the following comments.

Initially, the Office Action has objected to claims 3 and 13. Applicants have now amended claim 3 to depend from claim 2, and claim 13 has been cancelled without prejudice or disclaimer of subject matter. Accordingly, the objections raised have been obviated.

Claim 21 was rejected under 35 U.S.C. 112, first paragraph for allegedly failing to comply with the written description requirement. Specifically, the Office Action contends that the specification does not describe a sufficient number of species that would entitle claim 21 to convey possession of the entire genus encompassed by their simple esters.

Applicants respectfully disagree. One skilled in the art would have known that at the time of the invention that the phrase "simple esters" is commonly understood to denote monoesters, such as, for example aliphatic esters, aromatic esters, or alicyclic esters. Accordingly, Applicants respectfully request that the rejection of claim 21 be withdrawn.

Claim 20 was rejected under 35 U.S.C. § 112, second paragraph for allegedly failing to particularly point out that which applicants' regard as their invention. Claim 20 was further rejected under 35 U.S.C. § 101 for allegedly failing to set forth any steps involved in the

process, which results in an improper definition of a process. However, Applicants' respectfully wish to point out that claim 20, which depends from claim 1, is not directed to the use of the composition or a process for using the composition, but rather claim 20 further defines the composition of claim 1 as being a lipstick composition. Accordingly, Applicants respectfully request that the rejections of claim 20 based on § 112 and § 101 be withdrawn.

Claims 1-3, 9-18, 20-22, 27, 29-32 and 34 stand rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by U.S. Patent No. 6,451,329 (*Sandewicz et al.*). Claims 1-3, 9-22, 27-29 and 32-35 stand rejected under 35 U.S.C. § 102(b) for allegedly being anticipated by U.S. Patent No. 6,475,500 (*Vatter et al.*). Applicants respectfully traverse these rejections, in view of the comments set forth below.

One notable feature of independent claim 1 is a second film forming polymer obtained by polymerizing siloxane monomers and at least one ethylenically unsaturated monomer of the general formula:



wherein R_1 , and R_2 are each independently H, halogen, hydroxyl, fluoroalkyl, a C_{1-30} straight or branched chain alkyl, aryl, aralkyl; R_2 is a pyrrolidone, or a substituted or unsubstituted aromatic, alicyclic, or bicyclic ring where the substituents are C_{1-30} straight or branched chain alkyl, or COOM or OCOM herein M is a C_{1-30} straight or branched chain alkyl, pyrrolidone, or a substituted or unsubstituted aromatic, alicyclic, or bicyclic ring where the substituents are C_{1-30} straight or branched chain alkyl.

Sandewicz et al. describes a cosmetic composition that reduces the shiny

appearance of skin and cosmetically improves the appearance of skin imperfections. The composition has a pigmented emulsion that includes a cosmetically effective amount of mushroom extract.

The Office Action states that *Sandewicz et al.* discloses “silicone elastomers suitable for use as finishing enhancers, including cetearyl dimethicone/vinyl dimethicone cross polymer, dimethicone copolyol cross polymer, dimethicone cross polymer, dimethicone/phenyldimethicone cross polymer, dimethicone/vinyl dimethicone cross polymer, and mixtures thereof.” See column 11, at lines 17-24.

It appears that the Office Action has identified the above-mentioned polymers as polymers which correspond to the second film forming polymer recited in claim 1.

However, Applicants respectfully submit that the above-mentioned polymers would not qualify as the second film forming polymer. Specifically, the above-mentioned polymers are not obtained by polymerizing siloxane monomers and at least one ethylenically unsaturated monomer of the general formula:

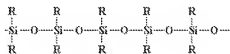


wherein R_1 , and R_2 are each independently H, halogen, hydroxyl, fluoroalkyl, a C_{1-30} straight or branched chain alkyl, aryl, aralkyl; R_2 is a pyrrolidone, or a substituted or unsubstituted aromatic, alicyclic, or bicyclic ring where the substituents are C_{1-30} straight or branched chain alkyl, or COOM or OCOM herein M is a C_{1-30} straight or branched chain alkyl, pyrrolidone, or a substituted or unsubstituted aromatic, alicyclic, or bicyclic ring where the substituents are C_{1-30} straight or branched chain alkyl.

In order for each of the above-mentioned polymers listed in *Sandewicz et al.* to conform to the ethylenically unsaturated monomer of general formula



R₁ or R₂ would have to be a silicone group, e.g.,



However, the general formula set forth in claim 1, does not permit R₁ or R₂ to be a silicone group. Anticipation requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. As such it is respectfully submitted that, claim 1 is not disclosed or suggested by *Sandewicz et al.*

Claims 2, 3, 9-12, 15-22 and 27-34 directly or indirectly depend on claim 1. For at least the same reasons discussed above for claim 1, these claims are patentable over *Sandewicz et al.*

Vatter et al. is directed to an anhydrous skin treatment composition, which includes a crosslinked siloxane elastomer gel having a specific yield point, a skin conditioning agent and a volatile siloxane. In column 6, lines 50 and 51, *Vatter et al.* states that the preferred organopolysiloxane compositions are dimethicone/vinyl dimethicone crosspolymers.

Dimethicone/vinyl dimethicone crosspolymers were also included in the above-mentioned list of *Sandewicz et al.* For the same reason discussed above for *Sandewicz et al.*, dimethicone/vinyl dimethicone crosspolymers do not fit within the general formula for the

ethylenically unsaturated monomer recited in claim 1, since R₁ or R₂ do not include a silicone group in their defined grouping.

Thus, it is clear that *Vatter et al.* does not disclose or suggest each and every element of the claimed invention. As such, it is respectfully submitted that claim 1 is not anticipated by *Vatter et al.*, since *Vatter et al.* does not disclose a second film former as set forth in claim 1. Similarly, dependent claims 2-3, 9-22, 27-29 and 32-34 are not anticipated.

Independent claim 35 is directed to a color cosmetic composition which uniquely combines a first film forming polymer which is a silicone resin, a second film forming polymer which is a silicone acrylate copolymer, and a nonpolar oil selected from a volatile paraffinic hydrogen, volatile silicone, or mixtures thereof, and pigments.

Applicants have reviewed *Vatter et al.* and have not found it to disclose or suggest the combination of a first film forming polymer which is a silicone resin, a second film forming polymer which is a silicone acrylate copolymer, a nonpolar oil selected from a volatile paraffinic hydrogen, volatile silicone, or mixtures thereof, and pigments as set forth in claim 35. As such, claim 35 is patentable over *Vatter et al.*

In view of the foregoing remarks, Applicants respectfully request favorable reconsideration and allowance of the claims in the present application.

Applicants' undersigned attorney may be reached in our New York office by telephone at (212) 218-2100.

Respectfully submitted,

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